



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,787	06/13/2006	Masato Kaneda	Q79148	5976
23373 7590 03/15/2011 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
EOFF, ANCA				
ART UNIT		PAPER NUMBER		
1722				
NOTIFICATION DATE		DELIVERY MODE		
03/15/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com  
PPROCESSING@SUGHRUE.COM  
USPTO@SUGHRUE.COM

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/582,787

**Applicant(s)**

KANEDA ET AL.

**Examiner**

ANCA EOFF

**Art Unit**

1722

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 March 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 3, 6, 12, 14, 16, 18 and 19

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

/Cynthia H Kelly/  
Supervisory Patent Examiner, Art Unit 1722

/Anca Eoff/  
Examiner, Art Unit 1722

Continuation of 11. does NOT place the application in condition for allowance because:

On page 3 of the Remarks, the applicant argues that the cleanability for the photosensitive composition containing a pigment varies with the number of carbon atom of aromatic hydrocarbon and that the content of each component is important. The examiner would like to point out that Kamayachi et al. (US Patent 4,953,516) clearly teach the use of tetramethylbenzene in a developer (column 15, lines 49-50). A developer removed the unexposed portions of a coating so the developer of Kamayachi et al. is equivalent to the "photosensitive composition remover" of the instant application.

The tetramethylbenzene is equivalent to the C10-based aromatic hydrocarbon of the instant application.

The examiner would also like to point out that the photosensitive composition of Kamayachi et al. may comprise as additive carbon black and titanium dioxide, which are well-known in the art as inorganic pigments.

Therefore, it is the examiner's position that Kamayachi et al. teach that a developer with tetramethylbenzene is effective for developing/removing unexposed portions of a photosensitive composition comprising a pigment.

Koyanagi et al. (WO 03/072634, wherein the citations are from the English equivalent US 2003/0153230) also teach that tetramethylbenzene may be used in a developer (par.0123).

Kamayachi et al. and Koyanagi et al. do not specifically teach tetramethylbenzene in an amount of 10-20 percent by mass in a developer.

However, Wyatt et al. (2003/0118946) teach that a developer may comprise an aromatic hydrocarbon in an amount of 20 percent by mass.

Therefore, one of ordinary skill in the art would have been motivated to use the tetramethylbenzene in an amount of 20% by mass in the developers of Kamayachi et al. and Koyanagi et al., this amount being clearly taught by Wyatt et al.

On pages 3-4 of the Remarks, the applicant argues that the prior art does not teach or suggest the problem addressed by the present invention (pigment tends to remain when removing a photosensitive composition containing a pigment) and a general method used to solve the problem is not known.

The examiner would like to point out that the independent claims 3 and 19 are not directed to a method but to a composition.

On page 4 of the Remarks, the applicant argues the combination of prior art (Kamayachi and Wyatt, Koyanagi and Wyatt) by pointing out that Wyatt teach a composition comprising 20% by weight of diisopropyl benzene (C12), which is not a C9 or C10 aromatic hydrocarbon.

The examiner would like to point out that Wyatt et al. was relied on for the teaching that a developer may comprise 20% by weight of an aromatic hydrocarbon. This teaching would motivate one of ordinary skill in the art to use an aromatic hydrocarbon, such as tetramethylbenzene, in amount of 20% by weight in the developer of Kamayachi et al. and Koyanagi et al.

On pages 5-6 of the Remarks, the applicant argues that the Examples 9-14 in table 1 of the specification are within the scope of the claims. The examiner agrees that the Examples 9-14 are within the scope of the claims. However, there is no comparison of the

composition of the instant application with the developer compositions of Kamayachi et al. and Koyanagi et al. (the closest prior art, which teach that the tetramethylbenzene may be used in a developer for a photosensitive composition).

Therefore, the rejections of record are maintained.